

REMARKS

Claims 1-3, 6, 12, 18-20, 24-27, 58-61 and 69-84 are pending in the application. Claims 1-3, 6, 12, 18-20, 24-27, 58-61 and 69-84 stand rejected.

I. OBVIOUSNESS DOUBLE PATENTING REJECTION

The Examiner has rejected claims 3, 58, 69, 70 and 72 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over cited claims in U.S. Patent No. 6,252,944. Applicants respectfully traverse all of these rejections, but in the interest of expediency, have filed herewith a terminal disclaimer overcoming such rejections. Applicants neither agree or disagree with any of the Examiner's assertions in paragraphs 2-6 on pages 3-4 of the Office Action.

II. CLAIM OBJECTION

Claim 20 is objected to for an insufficient antecedent basis problem. In response, Applicants have amended this claim to overcome this rejection. Applicants respectfully assert that the amendment to claim 20, and incorporated by reference in any claims depending therefrom, is not a narrowing amendment made for a reason related to the statutory requirements for a patent that will give rise to prosecution history estoppel.

III. DRAWING OBJECTIONS

The Examiner asserts that the DTMF receiver of claim 12, the recording buffer of claim 20, the circuitry for coupling a recording buffer in signal processing circuitry of claim 20, the switching circuitry and voice processing circuitry of claim 1 (and other claims), the plurality of telecommunications devices coupled to the system of claim 1 (and other claims), must be shown in the drawings or the features cancelled from the claims. In response, Applicants respectfully traverse these objections.

Figure 10 in the Application shows the DTMF receiver, recording buffer, and circuitry for coupling a recording buffer. All these circuitries in Figure 10 are labeled as 102, and thus part of DSP 102 in Figure 1. These are further described in the Specification on page 10, line 7 through page 12, line 2.

The signal processing circuitry is disclosed as DSP 102 and described on page 10, lines 3-6. The switching circuitry includes, among other things, items 103, 122 and 123 in Figure 3, including 306 and its lines to EKT phones 1400. The voice processing circuitry includes DSP 102 and the items in Figure 10. The plurality of telecommunications devices are EKTs 1400 in Figure 14 described on page 14, line 19, which are coupled to 306 in Figure 3.

IV. REJECTIONS UNDER 35 U.S.C. § 112

With respect to claim 18, the Examiner asserts that the phrase "off-hook state after the telecommunications device is connected to the call" is not clearly defined. In response, Applicants traverse this rejection. The telecommunications device in claim 18 is referring to the "one of a plurality of telecommunications devices" recited in claim 1, i.e., the called device.

With respect to claims 27 and 77, the Examiner has asserted that the phrase "the voice signal" is not clearly defined. In response, Applicants respectfully traverse this rejection. The voice signal of line 14 in these claims refers to the voice signal of line 9.

With respect to claim 71, the Examiner has asserted that the phrase "the plurality of telecommunications devices connected to the system as telephone extensions accessible solely through the switching circuitry" is not clearly defined. In response, Applicants respectfully traverse this rejection. Applicants have amended claim 71 to more clearly recite this claim limitation. Applicants respectfully assert that the amendment to this claim, and incorporated by reference in any claims

depending therefrom, is not a narrowing amendment made for a reason related to the statutory requirements for a patent that will give rise to prosecution history estoppel.

With respect to claim 83, the Examiner asserts that the phrase "such as" renders the claim indefinite. Applicants respectfully traverse. The limitations tied to this phrase are part of the claimed invention. Applicants should be given some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the Examiner might desire. MPEP § 2173.02. Office policy is not to employ *per se* rules to make technical rejections. *Id.* The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. *Id.* Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.*

The claim as written is clear since the "such as" language lists one of the capabilities of the voice processing circuitry described in the Specification. The mere use of the phrase "such as" in the claim does not by itself render the claim indefinite. *Id.* Office policy is not to employ *per se* rules to make technical rejections. *Id.*

V. REJECTIONS UNDER 35 U.S.C. § 102

Claims 1, 69, 74, 80-81 and 84 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Eisdorfer et al.* (U.S. Patent No. 5,960,348). In response, Applicants respectfully traverse these rejections. Claim 1 has been amended to more clearly recite the invention. Applicants assert that *Eisdorfer* does not anticipate

claim 1 before the amendment, but are making the amendment for further clarification.

In *Eisdorfer*, voice processing unit 116 is merely a voice recognition unit. Col. 4, line 51. *Eisdorfer* does not disclose that voice processing unit 116 automatically interacts with a call directed to a voice mailbox if a user of the telecommunications device does not answer the call.

Further, claim 69 recites that the one of a plurality of telecommunications devices is coupled to the system as extensions to the system. The Examiner does not even specifically address this claim language. For this reason alone, the Examiner has failed to prove a *prima facie* case of anticipation in rejecting claim 69. Furthermore, the Examiner has asserted that the telecommunications devices are taught in *Eisdorfer* as items 169 and 101. Applicants traverse. 169 is not an extension coupled to the system 105 or 131, but is at most possibly an extension of the Home MSC 161. System 159 is not part of system 105 or 131. Recall that the system recited in claim 69 has voice processing circuitry and switching circuitry controlled by a single microprocessor. Main processor 107, which the Examiner asserts is equivalent to a the single microprocessor recited in the claim does not control anything within system 159. Therefore, cell phone 169 is not part of system 105. Likewise, telephone 101 is also not part of the system 105 or 131, but is instead a telephone extension at most of a local exchange carrier (LEC) 103. LEC 103 is also not controlled by main processor 107. One skilled in the art would clearly understand that telephones 101 and 169 are not extensions to the system, as specifically recited within claim 69.

Claim 81 is patentable for at least the same reasons as given above with respect to claim 69. There is also nothing taught within *Eisdorfer* that the switch fabric 118 connects an incoming call to either of telephones 101 or 169 based on information accompanying an incoming call that identifies those particular telephones. It is more likely that switch fabric 118 may merely switch the incoming

call, based on information it receives with the call, to the LEC 103 or Home MSC 161, and then it is up to those switch systems to determine what connected telephone the incoming call should be switched to.

Claim 84 has been amended to be in independent form. 169 and 101 are clearly not separately operable telephone extensions coupled to the system, as similarly argued above with respect to claim 69.

VI. REJECTIONS UNDER 35 U.S.C. § 103

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Eisdorfer* as applied to claim 1 above, and in view of *Lohman* (U.S. Patent No. 5,526,397). Since claim 1 has been amended, this rejection is moot. Further, the Examiner asserts that *Eisdorfer* can be modified by *Lohman* to support system users conveniences of having a signal processing circuitry in the *Eisdorfer* voice processing circuitry. However, there is nothing in *Eisdorfer* that suggests that there is a need for such system users conveniences. An IXC switch has no need for such system users conveniences.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Eisdorfer* in view of *Lohman*, and further in view of *Pinede et al.* (U.S. Patent No. 4,554,413). In response, Applicants respectfully traverse this rejection. The arguments above with respect to claim 2 apply here also. Further, *Pinede* does not disclose a voice processing circuitry coupled to the crosspoint matrix 52. As such, one skilled in the art at the time the invention was made would not have been motivated to combine *Pinede* with *Eisdorfer* and *Lohman* in order to combine the crosspoint matrix 52 of *Pinede* with the system described in *Eisdorfer*. The Examiner has relied solely upon hindsight reasoning in finding a teaching in *Pinede* of a crosspoint matrix and combining it with *Eisdorfer* and *Lohman*. There is nothing within *Eisdorfer* that teaches or suggests that the switch fabric 118 could be a

crosspoint matrix. In fact, such a matrix would not work properly in the *Eisdorfer* system. Furthermore, there is nothing within *Pinede* that teaches or suggests that a cross point matrix as taught in *Pinede* could be used within a system such as *Eisdorfer*. Contrary to the Examiner's assertion in paragraph 15, page 10 of the Office Action, there is no need in *Eisdorfer* for the switch fabric to couple to multiple telephone stations. Instead, the switch fabric couples other switches together. And, the Examiner's stated motivation in paragraph 15 on page 10 of the Office Action is merely the Examiner's subjective opinion, which is insufficient to support a motivation to combine the references. Instead, the Examiner must provide objective evidence supporting such a motivation to combine. The Examiner has no such objective evidence, except for the Applicants' own disclosure, which is impermissible.

Claims 18-19, 24-27, 58-61, 71 and 77-79 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Eisdorfer* as applied to claim 1 above, and in view of *Cho* (U.S. Patent No. 5,544,231). In response, Applicants respectfully traverse these rejections. All arguments above with respect to *Eisdorfer* are incorporated.

The Examiner's motivation is provided in the first paragraph of page 11 of the Office Action. The problem with this stated motivation by the Examiner is that it is the Examiner's own subjective opinion, and is not supported with any objective evidence. The Federal Circuit has clearly established that objective evidence is required to support a motivation to combine references. An Examiner's subjective opinion does not amount to objective evidence. Furthermore, the system in *Eisdorfer* is an interexchange telephone carrier system, and has no need to record conversations. The voice processing unit 116 in *Eisdorfer* is merely a voice recognition unit. Any voice conversations recorded by voice processing unit 116 would not even be accessible by any telephone devices, such as devices 101 and 169 noted in *Eisdorfer*. In other words, telephone 101 would not be able to access any recorded voice

conversations in voice processing unit 116, and neither would telephone 169. As a result, the Examiner has failed to prove a prima facie case of obviousness.

With respect to claims 58-60, these claims are also patentable over *Eisdorfer* and *Cho* for reasons as given above with respect to the § 102 rejections of the claims. That is, *Eisdorfer* does not teach or suggest telephone extensions coupled to the system.

With respect to claims 27 and 61, column 2, lines 4-7 of *Cho* does not read on the claim language. The claims recite that the voice signal that is recorded originated from a voice mail message. *Cho* is merely teaching that a recorded telephone conversation can be played back. Therefore, the Examiner's rejection relies upon an incorrect factual predicate, and not all the limitations of the claims are taught or suggested by the cited prior art.

With respect to claim 71, Applicants traverse the Examiner's Official Notice. The Examiner has mischaracterized the claim language. The claim does not recite "solely for connecting the calls."

With respect to claim 83, Applicants do not understand why *Cho* was used to reject this claim, since it does not recite recording of a voice conversation. Nevertheless, claim 83 is patentable over *Eisdorfer* and *Cho*. *Eisdorfer* does not show extension lines coupling telephone devices 101 and 169 to switch fabric 118. Furthermore, *Eisdorfer* does not teach that the voice processing unit 116 interacts with the call for coupling the call to a voice mailbox associated with one of the telephone extensions.

Claim 73 and 82 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Eisdorfer* as applied to claim 1 above. In response, Applicants respectfully traverse this rejection. These claims are patentable since *Eisdorfer* does not teach the limitations recited in the claims from which these depend.

Claim 6 stand stands rejected under 35 U.S.C. § 103 as being unpatentable over *Eisdorfer* in view of *Van Berkum et al.* (U.S. Patent No. 6,028,925). In response, Applicants respectfully traverse this rejection. The combination of *Van Berkum* and *Eisdorfer* does not meet the claim limitations. *Van Berkum* merely teaches that the various software programs are executed by control processor 116 to service the telephone calls. However, there is no voice processing circuitry taught or suggested within *Van Berkum* that is also controlled by this set of software programs. At the most, voice response unit 108 is taught within *Van Berkum* as being separate from and therefore not controlled by the software programs and the control processor 116. As a result, the combination of *Van Berkum* and *Eisdorfer* still teaches away from the present invention. A combination of the two references would not teach to one skilled in the art at the time the invention was made that voice processing circuitry and switching circuitry could be controlled by a single set of software. Recall that claim 6 does not merely recite that the single processing means is controlled by a single set of software, but instead, claim 6 further recites that the switching circuitry and the voice processing circuitry are controlled by such a single processing means. Claim 6 further recites that this single set of software is operable for controlling both the switching circuitry and the voice processing circuitry. The Examiner has not even addressed this claim limitation. Thus, the Examiner has failed to prove a *prima facie* case of obviousness.

Regarding claim 75, the rejection is further traversed for similar reasons as given above with respect to claim 81.

Applicants traverse the rejections of claims 12 and 76 as being unpatentable over *Eisdorfer* in view of *Newlin* (U.S. Patent No. 6,011,579). The rejection of claim 12 is further moot since it has been amended. With respect to claim 76, there are no telephone extensions connected to switch fabric 118. Therefore, the combination of *Eisdorfer* and *Newlin* does not teach or suggest this claim limitation.

Claim 20 stands rejected over *Eisdorfer*, *Cho* and *Newlin*. Applicants traverse and incorporate all arguments above. Note further that none of the cited references, singularly or in combination, teach or suggest that signal processing circuitry includes a recording buffer. In fact, the Examiner has failed to specifically address this claim language. Further *Newlin* lists several DSP functions in the language cited by the Examiner, but specifically does not list recording buffer. Program memory and data memory as recited in *Newlin* is not the same as a recording buffer.

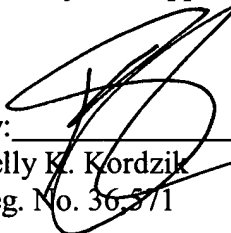
Claim 70 stands rejected as being unpatentable over *Eisdorfer* in view of *Pinede*. Applicants traverse as similarly argued above for claim 3. Claim 70 has also been amended.

Claim 72 stands rejected under 35 U.S.C. § 103 as being unpatentable over *Eisdorfer* in view of *Bertocci* (U.S. Patent No. 5,953,656). Applicants traverse for reasons as given above with respect to the use of *Eisdorfer* to reject the claims. Claim 72 has also been amended.

Respectfully submitted,

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